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Date of Deposit: December 13, 2002

Attorney Docket No.: 21402-258 (Cura 558)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Tchernev *et al.*

SERIAL NUMBER: 10/072,012

EXAMINER: Not Yet Assigned

FILING DATE: January 31, 2002

ART UNIT: 1632

TITLE: PROTEINS AND NUCLEIC ACIDS ENCODING SAME

Box DAC
Commissioner for Patents
Washington, D.C. 20231

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OFFICE OF PETITIONS

**PETITION FOR FILING PATENT APPLICATION
WHEN AN INVENTOR REFUSES TO EXECUTE UNDER 37 C.F.R. § 1.47(a)**

1. Pursuant to 35 U.S.C. § 116 and 37 C.F.R. § 1.47(a), the undersigned hereby petitions to allow each of the signing inventors to make application on his or her behalf as well as on behalf of the nonsigning joint inventor, Denise Lepley.
2. The inventors of the invention claimed in the above-referenced application are Velizar Tchernev, Kimberly Spytek, Bryan Zerhusen, Meera Patturajan, Richard Shinkets, Li Li, Esha Gangolli, Muralidhara Padigaru, David Anderson, Luca Rastelli, Charles Miller, Valerie Gerlach, Raymond Taupier, Jr., Vladimir Gusev, Steven Colman, Adam Wolenc, Carol Pena, Katarzyna Furtak, William Grosse, John Alsobrook II, Denise Lepley, Daniel Rieger, and Catherine Burgess, as identified in the unexecuted Combined Declaration and Power of Attorney that was submitted at the time this application was filed. Co-inventor Denise Lepley refuses to execute the Combined Declaration and Power of Attorney for this application. As required, Applicants enclose herewith copies of counterparts of the Combined Declaration and Power of Attorney form executed by the other co-inventors.
3. CuraGen Corporation was the employer of Denise Lepley (as well as the other co-inventors), at the time the invention, claimed in the present application (U.S.S.N. 10/072,012), which claims priority to U.S.S.N. 60/265,102, filed January 30, 2001; U.S.S.N. 60/265,514, filed January 31, 2001; U.S.S.N. 60/265,517, filed January 31, 2001; U.S.S.N. 60/265,412, filed January 31, 2001; U.S.S.N. 60/265,395, filed January 31, 2001; U.S.S.N. 60/266,406, filed

February 2, 2001; U.S.S.N. 60/266,767, filed February 5, 2001; U.S.S.N. 60/267,057, filed February 7, 2001; U.S.S.N. 60/266,975, filed February 7, 2001; U.S.S.N. 60/267,459, filed February 8, 2001; U.S.S.N. 60/267,823, filed February 9, 2001; U.S.S.N. 60/268,974, filed February 15, 2001; U.S.S.N. 60/271,855, filed February 27, 2001; U.S.S.N. 60/271,839, filed February 27, 2001; U.S.S.N. 60/273,046, filed March 2, 2001; U.S.S.N. 60/272,788, filed March 2, 2001; U.S.S.N. 60/275,989, filed March 14, 2001; U.S.S.N. 60/275,925, filed March 14, 2001; U.S.S.N. 60/275,947, filed March 14, 2001; U.S.S.N. 60/275,950, filed March 14, 2001; U.S.S.N. 60/276,450, filed March 15, 2001; U.S.S.N. 60/276,448, filed March 15, 2001; U.S.S.N. 60/276,397, filed March 16, 2001; U.S.S.N. 60/276,768, filed March 16, 2001; U.S.S.N. 60/278,652, filed March 20, 2001; U.S.S.N. 60/278,775, filed March 26, 2001; U.S.S.N. 60/278,778, filed March 26, 2001; U.S.S.N. 60/279,882, filed March 29, 2001; U.S.S.N. 60/279,884, filed March 29, 2001; U.S.S.N. 60/280,147, filed March 30, 2001; U.S.S.N. 60/283,083, filed April 11, 2001; U.S.S.N. 60/282,992, filed April 11, 2001; U.S.S.N. 60/285,133, filed April 20, 2001; U.S.S.N. 60/285,749, filed April 23, 2001; U.S.S.N. 60/288,327, filed May 3, 2001; U.S.S.N. 60/288,504, filed May 3, 2001; U.S.S.N. 60/294,047, filed May 29, 2001; U.S.S.N. 60/294,473, filed May 30, 2001; U.S.S.N. 60/296,964, filed June 8, 2001; U.S.S.N. 60/298,959, filed June 18, 2001; U.S.S.N. 60/299,324, filed June 19, 2001; U.S.S.N. 60/312,020, filed August 13, 2001; U.S.S.N. 60/312,908, filed August 16, 2001; U.S.S.N. 60/312,889, filed August 16, 2001; U.S.S.N. 60/313,930, filed August 21, 2001; U.S.S.N. 60/315,470, filed August 28, 2001; U.S.S.N. 60/316,447, filed August 31, 2001; U.S.S.N. 60/318,115, filed September 7, 2001; U.S.S.N. 60/318,118, filed September 7, 2001; U.S.S.N. 60/318,740, filed September 12, 2001; U.S.S.N. 60/323,379, filed September 19, 2001; U.S.S.N. 60/330,308, filed October 18, 2001; U.S.S.N. 60/330,245, filed October 18, 2001; U.S.S.N. 60/332,701, filed November 14, 2001; and U.S.S.N. 60/271,664, filed February 26, 2001, was conceived and reduced to practice. A copy of a CuraGen Corporation employment agreement executed by Denise Lepley on April 23, 2001, is attached to this petition. Under this agreement Denise Lepley is obligated to execute any and all applications for domestic and foreign patents covering inventions conceived, made, or discovered during the course of her employment

4. A Notice to File Missing Parts for this case was mailed on May 13, 2002. No executed Combined Declaration and Power of Attorney was received from Denise Lepley. Follow-up correspondence from colleagues of the undersigned to CuraGen Corporation did not result in receipt of an executed Combined Declaration and Power of Attorney from Dr. Lepley. Subsequently, the undersigned was informed that CuraGen Corporation was unable to obtain the executed document from Dr. Lepley.

5. On December 4, 2002, a representative of CuraGen Corporation sent a letter to Denise Lepley via Fed Ex mail, again asking her to execute the Assignment and Declaration corresponding to the instant application. The letter explicitly requested return of all executed documents by December 6, 2002.

6. On December 11, 2002, Jannine Malicki, the head of the Human Resources Department at CuraGen Corporation, spoke with Dr. Lepley regarding her obligation to execute the documents that were resent to her on December 4, 2002. During this conversation, Dr. Lepley said that she was not aware of the extent of the work she would have to do in order to sign all outstanding formal papers. According to Dr. Lepley, it was all more than she thought she would have to do. When she was reminded of her obligation under her Employment Agreement to sign all papers, she indicated that she would consider undertaking the work, if she were compensated for her time.

7. Finally, on December 13, 2002, the undersigned spoke with Denise Lepley regarding her obligation to execute the documents for the instant application. During this conversation, Dr. Lepley indicated that she would only execute the documents in exchange for compensation for her time from CuraGen Corporation.

8. Thus, based upon the record of correspondence to date, Denise Lepley has refused and continues to refuse to execute the Combined Declaration and Power of Attorney and to make application as a joint inventor of the present application.

9. Under the requirements set forth under 37 C.F.R. § 1.47, the last address of Denise Lepley known to the undersigned is:

University of Connecticut Health Center (Center for Vascular Biology)
ARB Bldg-E5052
263 Farmington Avenue
Farmington, CT 06030-3501

10. Submitted herewith is:

- 10.1 A copy of a written employment agreement between Denise Lepley and CuraGen Corporation signed April 23, 2001. (Exhibit A)
- 10.2 Combined Declaration and Power of Attorney counterparts executed by co-inventors Velizar Tchernev, Kimberly Spytek, Bryan Zerhusen, Meera Patturajan, Richard Shimkets, Li Li, Esha Gangolli, Muralidhara Padigaru, David Anderson, Luca Rastelli, Charles Miller, Valerie Gerlach, Raymond Taupier, Jr., Vladimir Gusev, Steven Colman, Adam Wolenc, Carol Pena, Katarzyna Furtak, William Grosse, John Alsobrook II, Daniel Rieger, and Catherine Burgess. (Exhibit B)
- 10.3 A copy of the December 4, 2002 letter from CuraGen Corporation to Denise Lepley requesting execution and return of the Combined Declaration and Power of Attorney for the present application. (Exhibit C)
- 10.4 A copy of the December 11, 2002 email from Jannine Malicki at CuraGen Corporation to the undersigned's colleague relaying Dr. Lepley's express refusal to execute these documents without compensation. (Exhibit D)
- 10.5 A check (#15130) in the amount of \$130.00 as required by 37 C.F.R. § 1.17(h).
- 10.6 A copy of the Response to Notice to File Missing Parts filed on December 13, 2002. (Exhibit E)

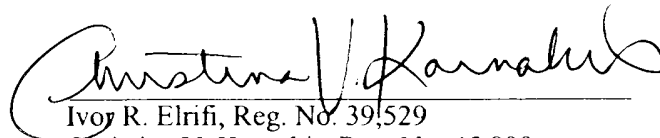
Based upon the pertinent facts presented herein, the undersigned hereby respectfully requests that application for the above-identified invention be made by each of the signing co-inventors on his or her behalf and on the behalf of the nonsigning co-inventor, Denise Lepley. To that end, the undersigned, on behalf of the signing co-inventors, respectfully requests consideration and grant of this petition for filing the patent application by less than all of the co-inventors pursuant to 37 C.F.R. § 1.47(a).

Should the Commissioner have any questions concerning this petition, he is invited to telephone the undersigned at the number provided.

U.S.S.N. 10/072,012
Applicants: Tchernev *et al.*

Respectfully submitted,

Dated: December 13, 2002

A handwritten signature in dark ink, appearing to read "Christina V. Karnakis", is written over a horizontal line.

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